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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,891	09/26/2003	Jonathan S. Stinson	10527-450001/ 02-303	9546
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EXAMINER				
ROE, JESSEE RANDALL				
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1793				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/672,891

Applicant(s)

STINSON, JONATHAN S.

Examiner

Jessee Roe

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,9-12,14-21 and 41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,9-12,14-21 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Claims

Claims 1-6, 9-12, 14-21 and 41 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1-6, 9-12, 14-15 and 18-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not contain support for a molybdenum base alloy as previously set forth in the Office Action of 29 October 2007 with the recitation "with the proviso that the alloy includes at least about 3 weight percent of Mo". MPEP 2163.05 (I) & (III).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 9-10, 12, 14, 15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischell et al. (US 5,643,312) in view of Steinemann et al. (US 4,040,129).

Claims 1-6, 9-10, 12, 14, 15 and 19 are rejected on the same grounds as set forth in the Office Action of 29 October 2007.

Claims 1-6, 11-12, 14-15, 19 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lau et al. (US 5,728,158) in view of Lenning et al. (US 3,161,503).

Claims 1-6, 11-12, 14-15, 19 and 41 are rejected on the same grounds as set forth in the Office Action of 29 October 2007.

Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lau et al. (US 5,728,158) in view of Lenning et al. (US 3,161,503), and further in view of the ASM Handbook Volume 2.

Claims 16-18 are rejected on the same grounds as set forth in the Office Action of 29 October 2007.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fischell et al. (US 5,643,312) in view of Steinemann et al. (US 4,040,129), and further in view of Scott et al. (US 5,383,928).

Claim 20 is rejected on the same grounds as set forth in the Office Action of 29 October 2007.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lau et al. (US 5,728,158) in view of Lenning et al. (US 3,161,503), and further in view of Scott et al. (US 5,383,928).

Claim 20 is rejected on the same grounds as set forth in the Office Action of 29 October 2007.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fischell et al. (US 5,643,312) in view of Steinemann et al. (US 4,040,129) as applied to claim 1 above, with evidence from Wiktor (US 5,653,727).

Claim 21 is rejected on the same grounds as set forth in the Office Action of 29 October 2007.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lau et al. (US 5,728,158) in view of Lenning et al. (US 3,161,503) as applied to claim 1 above, with evidence from Wiktor (US 5,653,727).

Response to Arguments

First, the Applicant primarily argues that the rejection of claims 1-6, 9-12, 14, 15 and 18-21 under 35 U.S.C. 112, first paragraph is in error because the claims do not claim a molybdenum base alloy and this rejection should be withdrawn. In response to this argument the Examiner notes that the only other required element would be titanium with the recitation "...including an alloy having Ti at about 20 weight percent or more and *at least one of* Zr, Ta, or Mo, wherein the alloy includes 20 weight percent or greater of Zr, Ta, Mo, or a combination thereof, with the proviso that the alloy includes

at least about 3 weight percent of Mo" (emphasis added by the Examiner). The claims recite a minimum of 20 weight percent Mo with no upper limit. Thus, the claims encompass any amount of Mo including for example, 50, 60, 70 weight percent Mo, that is, the claims encompass Mo based alloys. Thus, the scope of claim 1 would include a molybdenum base alloy which is not found in the instant specification.

Second, the Applicant primarily argues that one having ordinary skill in the art of stent design would recognize that the Steinemann ('129) alloy is irrelevant to stent design because stents are not implanted within the bone. In response, the Examiner notes that the scope of the alloys disclosed by Steinemann ('129) would not be limited to alloys implanted in the bone, but rather to any surgical implant (col. 3, lines 47-58), which would include a balloon-expandable stent.

Third, in response to applicant's argument that the examiner's conclusion of obviousness with respect to Lau et al. ('158) in view of Lenning et al. ('503) is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Fourth, the Applicant primarily argues that Lau et al. ('158) does not support the statement set forth by the Examiner that the stent of Lau et al. ('158) would be fabricated from titanium and/or tantalum alloys where corrosion resistance would be

desired. The Applicant further argues that Lenning et al. ('503) describes alloys as having "the corrosion resistance of tantalum in their ability to withstand corrosive effects of solutions such as boiling hydrochloric, sulfuric, phosphoric or oxalic acids." (col. 1, lines 20-25) and this would not be the type of environment experienced by a stent when implanted within a body lumen. In response to the first argument, the Examiner asserts that the stent of Lau et al. ('158) would provide a balloon-expandable stent fabricated from titanium and/or tantalum alloy where corrosion resistance would be of concern. Figures 2-4 show a balloon-expandable stent. At column 7, lines 5-8, the word "alloys" succeeds the phrase "stainless steel, titanium, tantalum, superelastic NiTi". Because alloys would apply to both the first (stainless steel) and last (NiTi) of the group, it would be expected that the reference would be referring to titanium alloys and tantalum alloys as well. At column 8, line 30, Lau et al. ('158), apply corrosion inhibitors to the stent. Therefore, corrosion resistance would be a desired characteristic for stents, as disclosed by Lau et al. ('158). In response to the second argument, the Examiner notes that the main acid found in the stomach would be hydrochloric acid and the claims do not limit the uses the stent to exclude the stomach of a human body as an intended use of the medical stent. Therefore, it would be expected that the alloys disclosed by Lenning et al. ('503) would be capable of use in the stomach of a human body containing hydrochloric acid because Lenning et al. ('503) disclose that ability of the alloy to withstand a solution of boiling hydrochloric acid (col. 1, lines 20-25).

Fifth, in response to applicant's argument that the rejection is in error because the alleged reason would not have actually prompted one having ordinary skill in the art

of stent design to make the balloon expandable stent of Lau et al. ('158) out of the alloy disclosed by Lenning et al. ('503), the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jesse Roe whose telephone number is (571) 272-5938. The examiner can normally be reached on Monday-Friday 7:30 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JR

/John P. Sheehan/
Primary Examiner, Art Unit 1793